

REMARKS

Claims 1 and 3-5 have been amended. Claims 1-5 are currently pending and under consideration.

On page 3 of the Office Action, claims 1-5 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,008,935 (Fujita).

On page 2 of the Office Action, the Examiner stated that Applicants argument regarding the claim language "a total power measuring unit that measures the light power of said optical signals of all wavelengths at said measuring point" is not convincing.

According to the Examiner, 1550nm is the only wavelength transmitted in the apparatus of Fujita. The Examiner cited column 7, lines 45-50 and figs. 3A-3C of Fujita.

By its language, 35 U.S.C. § 102 requires that each and every element of a claim be present in a single cited reference to properly have the reference anticipate the claim. *See In re Bond*, 910 F.2d 831, 15 USPQ2d 1566, 1567 (Fed. Cir. 1992), *citing Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675,677, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988); *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984); *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992); and *Elmer v. ICC Fabricating Inc.*, 67 F.3d 1571, 36 USPQ2d 1417, 1419 (Fed. Cir. 1995).

Applicants respectfully submit that in the present invention, the specific wavelength measuring unit and the total power measuring unit measure the optical signal as received at the photo signal input terminal and split by the optical splitter without filtering, as recited in the language of independent claim 1.

In contrast, in Fujita, the optical signals measured by the photo detectors 50 and 51 are filtered by "tunable wavelength filter" 31. The tunable wavelength filter 31 transmits a specific wavelength component included in the light branched by the optical splitter 21 (column 8, lines 26-28). Since the optical signals measured by the photo detectors 50 and 51 in Fujita are filtered by the tunable wavelength filter 31, unlike the present invention, the system disclosed in Fujita cannot solve the problems described in the related art section of the specification, for example.

Applicants respectfully submit that the claims of the present invention are patentable over the reference, as the reference fails to teach each and every element of the claims. Applicants respectfully submit that as the Examiner acknowledges on page 2 of the Office Action and as

indicated in Fujita, the central wavelength of 1550 nm is simply inputted into the light amplifier unit. See Office Action, page 2, item 6. See *also* Fujita, column 7, lines 45-47.

Applicants further submit that the amplifier unit is not "a total power measuring unit," as in the present invention, structurally or otherwise. In fact, the amplifier is not a measuring unit, period.

Applicants' previous argument buttresses Applicants' argument regarding Fujita's amplifier unit not being tantamount to Applicants measuring unit. That is, a measuring unit measures, and an amplifier unit amplifies. The devices are completely different from one another.

Moreover, regarding the Examiner's argument that the claim language is functional, in *In re Schreiber*, the absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of the claimed apparatus. The limitations at issue, however, were found to be inherent in the prior art reference. See *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). By contrast, in the present invention, Applicants respectfully submit that measuring light power of optical signals of all wavelengths at a measuring point is not an inherent function of an amplifier.

In light of the foregoing, Applicants respectfully submit that claims 1, 5, and 9 are patentable over Fujita, as Fujita does not teach a total power measuring unit, for example. Withdrawal of the rejection is respectfully requested.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

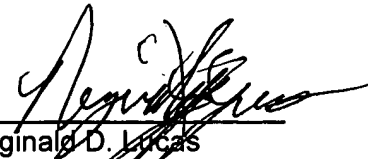
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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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